

Attorney's Docket No.: 06618-406001/CIT2940

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

The claims stand objected due to informalities which have been corrected herein.

Claim 18 stands rejected under 35 USC §101, as allegedly being directed to non-statutory subject matter. This contention is respectfully traversed. The rejection essentially reasons that putting the 'process of making' and 'process of using' in the same claim crosses statutory classes. However, according to §101, the classes of claims include process, machine, manufacture or composition of matter. Since the patent office's own analysis of the claim shows that all parts of it are directed to "processes", the rejection under 35 USC §101 is respectfully traversed.

The word "substantially" has been removed to obviate the §112 rejection to Claims 7-10 and 12.

Claim 12 has been amended to depend from Claim 7 to obviate the rejections under §112. The rejection of Claim 18 under §112 is respectfully traversed, since the rejection on this basis has nothing to do with the statute or any other legal theory, and the statement that a person having ordinary skill in the art

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would not understand how to both make and use the process is respectfully traversed.

Claims 7, 8, 10, 13, 14, 18, 20 and 23-26 stand rejected under 35 USC §103(a) as allegedly being unpatentable over Serpico et al. in view of the Zonyl reference and further in view of Trainham, III et al. This contention is respectfully traversed, and for reasons set forth herein, the combination is made based entirely on hindsight.

The rejection admits that Serpico et al. does not teach explicitly adding an ionomer to the catalyst ink. The rejection uses Trainham, III et al., which does show using a Nafion ionomer in a catalyst ink, see column 8 lines 9-24. However, the reason for adding the Nafion ionomer in Trainham, III et al. is "to enhance the catalyst-ionomer surface contact and to act as a binder to the Nafion membrane sheet". That is, Trainham, III et al. does teach adding Nafion, but teaches adding Nafion only as a binder. In other words, there is no teaching or suggestion in Trainham, III et al. which would lead a person of ordinary skill in the art to the claimed subject matter of adding an ionomer with "a property of improving ion conduction". The ionomer in Trainham, III et al. is only added for the purpose of improving binding, not for improving ion conduction.

For these reasons, a person having ordinary skill in the art would not operatively make the combination of Serpico et al.

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in view of Zonyl and further in view of Trainham, III et al. The reasons for making this combination are those set forth in the present specification, not the prior art. The teaching in Trainham, III et al. would not lead a person having ordinary skill in the art to make this combination.

Many of the dependent claims should also be allowable for analogous reasons. Claims 23-26 define that the ionomer is Nafion configured as an ion conducting material. Nowhere does the prior art teach or suggest this feature. At least one form of Nafion is ion exchange, not ion conduction. The configuration of Nafion is in no way taught or suggested. Claims 23-26 should hence be allowable for these reasons.

Claim 13 defines a catalyst ink with water, ionomer, and a catalytic material with platinum and another catalytic material. Carbon fiber paper is also prepared by adding fluorocarbon polymer. There is no teaching or suggestion of this combination in the cited prior art. Therefore, the claims of this type, including Claims 13, 18 and 19, which define a substrate of carbon fiber paper that has fluorocarbon polymer added thereto, should be additionally allowable for the reasons.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition,

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because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants ask that all claims be allowed. No fee is believed to be due, however please apply any applicable charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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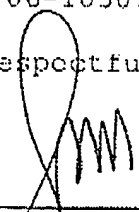
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